REMARKS

Claims 1-24 are pending. Claims 18-24 are drawn to nonelected subject matter and are withdrawn from consideration. Applicants acknowledge that the Examiner has rejoined claims 18-24 (drawn to processes of making compounds of claim 1) to the extent that they comport in scope with the elected product claims (Action, page 2, part 2). Pursuant to MPEP § 821.04, Applicants present new claims 25-29, directed to processes of making the compounds of claim 1, for rejoinder with product claims 1-17. Claim 25 includes the subject matter of claims 18 and 19 as originally filed and comports in scope with present product claim 1. Therefore, as required by the rejoinder procedure, claim 25 includes all of the limitations of claim 1 as currently amended. Claims 26-29 include the limitations of claims 20-23, respectively, as originally filed. Applicants respectfully request entry of these amendments under 37 C.F.R. 1.116.

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No.: 6,465,467. Applicants submit herewith a terminal disclaimer under 37 C.F.R. 3.73(b) and 1.321 (b) and respectfully request that the rejection be withdrawn.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being obvious over Nilsson et al, U.S. Patent No.: 6,465,467 (the '467 Patent). According to the Action:

> The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). (Action, page 3, part 5, emphasis added).

Applicants point out the provisions of 35 U.S.C. 103(c), which apply to all utility applications filed on or after the November 29, 1999 date of enactment:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the

> claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Pursuant to MPEP § 706.02(1)(2) and "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)" 1241 OG 96 (December 26, 2000), Applicants provide the following statement as evidence of common ownership of the present application (filed on November 19, 2001) and the '467 Patent:

> United States Patent Application Serial No.: 09/988,966 and United States Patent 6,465,467 B1 were, at the time the invention of United States Patent Application Serial No.: 09/988,966 was made, owned by Biovitrum AB.

Thus, the present application, filed after November 29, 1999, and the '467 Patent were therefore commonly owned at the time that the present invention was made. As such, the '467 Patent, which qualifies as prior art only under 35 U.S.C. 102(e) (see passage from the Action recited above) cannot preclude patentability of the claimed invention under the provisions of 35 U.S.C. 103(c). The '467 Patent must therefore be disqualified from being used in the rejection of claims 1-17 under 35 U.S.C. 103(a). Applicants respectfully request that the rejection be with drawn for the reasons set forth above.

No fee is believed due with this reply. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No.: 13425-055001.

Respectfully submitted,

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